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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/859,565   | 05/16/2001  | Jeffrey H. Alger     | 03797.00014         | 4100             |
| 28319  | 7590        | 03/24/2006           | EXAMINER            |                  |
| BANNER & WITCOFF LTD.,<br>ATTORNEYS FOR CLIENT NOS. 003797 & 013797<br>1001 G STREET , N.W.<br>SUITE 1100<br>WASHINGTON, DC 20001-4597 |             |                      | VIG, NARESH         |                  |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             | 3629                 |                     |                  |
| DATE MAILED: 03/24/2006  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/859,565             | ALGER ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Naresh Vig             | 3629                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 December 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-12,14-17,19-22,24-26,28 and 30-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-12,14-17,19-22,24-26,28 and 30-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

This is in reference to response received 22 December 2005 and 01 September 2005. Claims 1 – 3, 5 – 12, 14 – 17, 19 – 22, 24 – 26, 28 and 30 – 42 are pending for examination.

### ***Election/Restrictions***

Applicant's election with traverse of claims 1 – 3, 5 – 12, 14 – 17, 19 – 22 and 24 – 25 in the reply filed on 22 December 2005 is acknowledged. The traversal is on the ground(s) that amended claims do not present undue burden for examination. This is not found persuasive because for example claim 1 claims core portion including a browse application whereas in for example, claim 30 includes a browser (a browser is a common terminology for a Software program used to view and interact with various types of Internet resources available on the World Wide Web. Netscape and Internet Explorer are two common examples).

If the applicant in their understanding believe that the Election/Restriction is improper, applicant must amend the limitation in the pending claims of "browser" to "browse application" to claim the single invention as claimed in claim 1 in the application.

***Response to Arguments***

Applicant's arguments and concerns for amended claims have been responded in response to the pending claims in the application.

In response to applicant's argument that examiner rejected claims 1, 2, 4-23, 26, 27, 30, 31, 33, 34, 36, 37, 39 and 43 under 35 U.S.C.- §102(b) over Web pages ostensibly made available on the Internet by 1stUp.com over dates between November 2, 1999, and February 13, 2001, hereafter referred to as the "1stUp.com pages.", and, as argued as foot note of page 11 of the response received 01 September 2005 applicant reserves the right to challenge the applicability of the 1stUP.com pages as prior art to the instant application.

However, applicant can check the dates of the specific pages of 1stUP.com reference cited in this office action by reading the URL of the cited web page, where the date is in YYYYMMDD format.

In response to applicant's argument that 1stUP.com appear to disclose a small application that is downloaded and used in conjunction with a conventional browser (i.e., a browser that does not evoke as association with a merchant), and, 1stUP.com pages teach providing the navigation bar to the user separately from the browser software, and designed to be used with a conventional browser, teaches away from the invention as recited in claims 1-3, 5-12, 14-17, 19-22, 24 and 25.

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However, applicant is claiming a browser application and arguing the limitation as a browser. A browser is a common terminology for a Software program used to view and interact with various types of Internet resources available on the World Wide Web. Netscape and Internet Explorer are two common examples. Applicant agrees 1stUP uses a browser. If the applicant is claiming that their claimed limitation of browser application is actually a browser, then, applicant's invention is also using a browser as taught by the cited 1stUP reference.

In response to applicant's argument that cited reference 1stUP.com does not teach second data field contains functionality branding that provides the core data with at least one function that evokes an association with a merchant.

However, 1stUP teaches functionality branding that provides the core data with at least one function that evokes an association with a merchant (the sponsoring merchant).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5 – 12, 14 – 17, 19 – 22, 26, 30, 31, 33, 34, 36, 37 and 39 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant claims limitation of "browser application", and, argues the limitation as a "browser". It is known to one of ordinary skill in the art at the time the invention was made that a browser is a common terminology for a Software program used to view and interact with various types of Internet resources available on the World Wide Web. Netscape and Internet Explorer are two common examples of a browser. To further expedite the prosecution of the application, examiner reads claimed limitation of "browser" as claimed limitation of "browser application".

### ***Claim Rejections - 35 USC § 102***

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 5 – 12, 14 – 17, 19 – 22, 26, 30, 31, 33, 34, 36, 37 and 39 are rejected under 35 U.S.C. 102(a) as being unpatentable over 1stUP by 1stUP.com hereinafter known as 1stUP.

Regarding claim 1, 1stUP teaches system and method for distributing variations of electronic data through multiple merchants to purchasers (users, subscribers, end users). 1stUP teaches:

publishing a first variation of electronic data for a first merchant to make available to purchase, the first variation having a core portion including a browser application (provides internet access to users) for retrieving and rendering content and a first merchant-specific portion [page 6, 10 – 11, 26 – 34];

publishing a second variation of the electronic data for a second merchant to make available to purchasers, the second variation having the core portion and a second merchant-specific portion [page 6, 10 – 11, 26 – 34], and

such that the first merchant-specific portion differs from the second merchant-specific portion so that a purchaser's viewing or execution of the first variation evokes an association with the first merchant and a purchaser's viewing or execution of the second variation evokes an association with the second merchant.

Regarding claim 2, 1stUP teaches:

the first merchant adds the first-merchant specific portion to the core portion to produce the first variation [page 23], and

the second merchant adds the second-merchant specific portion to the core portion to produce the second variation [page 31].

Regarding claim 5, 1stUP teaches browser application rendering of content using the first variation evokes an association with the first merchant [page 28].

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Regarding claim 6, 1stUP teaches core portion is a commerce application for purchasing goods or services, such that the purchase of goods or services using the first variation evokes an association with the first merchant (e.g. link to WJLA) [page 28].

Regarding claim 7, 1stUP teaches core portion is a commerce application for purchasing goods or services from the first merchant (field of use, e.g. link to merchant site like WJLA) [page 28].

Regarding claim 8, 1stUP teaches core portion is a commerce application for purchasing content (field of use, e.g. link to merchant site like WJLA) [page 28].

Regarding claim 9, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling an appearance of the browser during execution [page 29].

Regarding claim 10, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing a user interface for the browser during execution that displays at least one image associated with the first merchant (design choice) [page 28].

Regarding claim 11, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling one or more functions of the browser application during execution (link to WJLA) [page 28].

Regarding claim 12, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing added functionality to the browser application during execution, such that the added functionality relates to the first merchant (link to WJLA) [page 28].

Regarding claim 14, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing function controls in a user interface for the browser that facilitate the retrieval of content from only sites associated with the first merchant (link to WJLA) [page 28].

Regarding claim 15, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by providing function controls in a user interface for the browser that facilitate the retrieval of specific content associated with the first merchant (link to WJLA) [page 28].

Regarding claim 16, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by controlling an operation of the browser application during execution (link to WJLA) [page 28].

Regarding claim 17, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting or expanding the operation of the browser application during execution (link to WJLA, adding links to external sites etc.) [page 28, 31].

Regarding claim 19, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting the operation of the browser to the retrieval of content from only sites associated with the first merchant (link to WJLA) [page 28].

Regarding claim 20, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting the operation of the browser to the retrieval of specific content associated with the first merchant (link to WJLA) [page 28].

Regarding claim 21, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by limiting operation of the browser application so that the browser application may retrieve content from designated sites only when the browser application is executing at a physical location defined by the first merchant (design choice, link to WJLA) [page 28].

Regarding claim 22, 1stUP teaches first-merchant specific portion evokes an association with the first merchant by facilitating cooperation between the browser application and another executable program associated with the first merchant (design choice, link to WJLA) [page 28].

Regarding claim 26, with respect to the recitation in claim 26 defining what kind of data is being stored on the database, this is considered to be non-functional descriptive material that does not distinguish (define) over the applied prior art. Since the instant claims are article claims and the type of data claimed is considered to be non-functional descriptive material, the applied prior art satisfies the claim. The prior art stores data and is fully capable of storing the claimed type of data, this is the extent to which weight will be given to the claimed data. When descriptive material is not functionally related to the article, the descriptive material will not distinguish the invention from the prior art in terms of patentability, *In re Gulack*, 217 USPQ 401 (CAFC 1983).

1stUP teaches computer readable medium with the capability for having stored thereon a data structure to comprise.

a first data field containing core data such that, when executed by a computer, the computer performing one or more functions [page 11]; and

a second data field containing functionality branding data for modifying the performance of the functions of the core data such that the functionality branding data

provides the core data with at least one function that evokes an association with a merchant (sponsoring merchant) [page 11].

Regarding claim 30, 1stUP teaches method of selling branded software. 1stUP teaches:

- receiving a software application including a browser application for retrieving and rendering content (for example signup screen) [page 11 – 34];
- branding said software application [page 11 – 34];
- forwarding said branded software application to a user [page 11 – 34].

Regarding claim 31, 1stUP teaches transmitting said branded software application to said user over the Internet [page 2].

Regarding claim 33, 1stUP teaches method of selling branded software comprising the steps of:

- receiving a software application with multiple brandings, the software application including a browser application for retrieving and rendering content [page 11 - 34];
- preventing access to at least one of the multiple brandings associated with said software application (customized solution) [page 11 - 34];
- forwarding said branded software application to a user [page 2].

Regarding claim 34, 1stUP teaches transmitting said branded software application to said user over the Internet [page 2].

Regarding claim 36, 1stUP teaches method of selling branded software. 1stUP teaches:

receiving a software application including a browser application for retrieving and rendering content [page 11 – 34];

adding multiple brandings to said software application (customization, [page 11 – 24]);

forwarding said branded software application to a user [page 2].

Regarding claim 37, 1stUP teaches transmitting said branded software application to said user over the Internet [page 2].

Regarding claim 39, 1stUP teaches method of branding software. 1stUP teaches:

receiving a software application including a browser application for receiving and rendering content [page 11 – 34];

adding at least one branding to said software application (customization) [page 11 – 34].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 24, 25, 28, 29, 32, 35, 38, 40 – 42 and 44 – 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over 1stUP.com hereinafter known as 1stUP.

Regarding claim 3, 1stUP does not specifically teach publisher provides the core portion to the first merchant with both the first-merchant specific portion and the second-merchant specific portion (receives sample code to tailor it to meet business requirements, add logo, change business address etc.), and the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation (tailors the code to meet business requirements, e.g. add business logo, change address, phone numbers, product information). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that businesses modify existing code to their requirements to reuse the code readily available. For example, contents of a web page.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify 1stUP and allow sponsors to make modification to existing software to reuse the software for plurality of clients.

Regarding claim 24, 1stUP does not specifically teach first-merchant specific portion is integrated with the core portion such that the first-merchant specific portion cannot be replaced by a portion specific to another merchant without damaging the first variation. However, as responded to earlier in response to claim 3, it would have been obvious to one of ordinary skill in the art at the time the invention was made that when a code is modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made such that the first-merchant specific portion cannot be replaced by a portion specific to another merchant without damaging the first variation to be able to make modifications and save the changes made to the original version.

Regarding claim 25, 1stUP does not specifically teach first-merchant specific portion is integrated with the core portion such that the first-merchant specific portion cannot be deleted from the first variation without damaging the first variation. However, as responded to earlier in response to claims 3 and 24, it would have been obvious to one of ordinary skill in the art at the time the invention was made that when a code is modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made such that first-merchant specific portion is integrated with the core portion such that the first-merchant specific portion cannot be deleted from the

first variation without damaging the first variation to be able to make modifications and save the changes made to the original version.

Regarding claim 28, 1stUP does not specifically teach second data field contains branding information for a plurality of merchants, such that all of the branding information except for branding information relating to a single merchant must be deleted or deactivated before a computer may properly perform the one or more functions. However, as responded to earlier in response to claims 3 24, and 25, it would have been obvious to one of ordinary skill in the art at the time the invention was made that when a code is modified, original version is damaged.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made such that second data field contains branding information for a plurality of merchants, such that all of the branding information except for branding information relating to a single merchant must be deleted or deactivated before a computer may properly perform the one or more functions variation to be able to make modifications and save the changes made to the original version.

Regarding claim 29, as responded to earlier in response to claims 26 – 29, 1stUP teaches:

appearance branding data for modifying an appearance of the performance of the functions;

operational branding data for modifying the operation of the functions; and

functionality branding data for modifying the performance of the functions.

Regarding claims 32, 35 and 38, 1stUP does not specifically teach selling said branded software in a store. However, 1stUP teaches distributing software free of charge to end users, and charging fee to sponsors for providing customized solution [page 2 – 34].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to sell branded software in store to generate revenue to market product at point of sales. For example, Kmart providing access to their "[www.bluelight.com](http://www.bluelight.com)" (commercially available at the time of invention) in stores selling of \$0.00 (free of charge).

Regarding claims 40 – 42, 1stUP does not specifically teach where the adding step (customization) occurs. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that it is a business choice to decide how to customize the application to meet client's business requirements. A business may elect to make change at the software application provider (hardcode the customization) to generate service revenue, make change at the merchant (allow merchant to hardcode the customization) to minimize support expenses, make change at the location of end user (dynamic customization) to control the customization for paying sponsors only.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR 1.111 (c) to consider the references fully when responding to this office action.

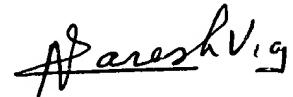
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Examiner  
Art Unit 3629

March 20, 2006